

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION
No 2016809 BY CLASSIC MANUFACTURING (AUST) PTY LTD TO
REGISTER A MARK IN CLASS 25**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No 45259
BY ASCO GROUP LIMITED**

TRADE MARKS ACT 1994

5 **IN THE MATTER OF trade mark Application
No 2016809 by Classic Manufacturing (Aust)
Pty Ltd to register a mark in Class 25**

and

10 **IN THE MATTER OF Opposition thereto under
No 45259 by ASCO Group Limited**

15 **DECISION**

On 7 April 1995 (but claiming an international priority date of 10 February 1995) Classic
Manufacturing (Aust) Pty Limited applied to register the following mark in Class 25 for a
20 specification of goods which reads “football jerseys, football shirts, football socks, tracksuits,
football training shirts”:-



The application is numbered 2016809.

35 On 29 August 1996 Asco Group Limited filed notice of opposition to this application.

The grounds of opposition are in summary that:-

- 40
- (i) the opponents are the proprietors of the applications and registrations, details of which appear below;
 - (ii) the mark applied for is similar to the earlier trade marks owned by the
- 45
- opponents and is to be registered for identical or similar goods to those for which the opponents' trade marks are registered. This goes to Section 5(2)(b) of the Act;

(iii) the device appearing in the mark so nearly resembles the kangaroo devices of the opponents that use of the former would be liable to be prevented by virtue of the provisions of the Copyright, Designs and Patent Act 1988. This goes to Section 5(4)(b) of the Act;

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(iv) the mark is not capable of distinguishing the goods of the applicants and so offends against Section 3(1)(a) of the Act.

The applications and registrations referred to in (i) above are as follows:-

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No	Mark	Class	Status	Specification
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1520185		25	Pending	Footwear; outerwear, athletic wear, headwear, hosiery; all included in Class 25; but not including goods made from kangaroo skin or in the form of kangaroos.
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1520188	KANGAROOS	25	Pending	Footwear; articles of outerwear and athletic wear; headwear; hosiery; all included in Class 25; but not including goods made from kangaroo skin or in the form of kangaroos.
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1581658		25	Registered (6116/2014)	Footwear, outerwear, athletic wear, headwear, hosiery; all included in Class 25; but not including goods made from kangaroo skin or in the form of kangaroos.
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Note This case has in fact been merged under the provisions of Section 41 of the Act and is continuing as No 1581659

1228133	KANGAROOS	25	Registered (5684/1805)	Articles of sports clothing but not including footwear.
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The applicants filed a counterstatement making a number of detailed denials and non-admissions. I do not think I need record these in detail though I note here that they admit that the opponents are the proprietors of three of the applications or registrations referred to above but deny that the opponents are the proprietors of No 1228133. They also put the opponents to proof on various issues. The upshot is, however, that they believe their application should be allowed to proceed to registration.

Both sides seek an award of costs in their favour.

Both sides filed evidence in these proceedings but neither has requested a hearing. Acting on the Registrar's behalf and after a careful study of the papers I now give this decision on the basis of the papers filed.

Before I go on to review the evidence a few preliminary comments are needed. The central point at issue in this case seems to me to be the position under Section 5(2)(b). Neither side has suggested that for the purposes of that test the goods themselves can be differentiated. That must be right as, without doubt, identical and similar goods are involved. The matter, therefore, resolves itself into one of a comparison of the respective marks. This is essentially a matter for the Tribunal to decide and is, generally speaking, not a matter for evidence.

Despite this the parties have between them filed ten statutory declarations. A considerable amount of effort has been devoted to claim and counter-claim in relation to the marks themselves and particularly the word CLASSIC appearing in the applicants' mark. I do not regard much of this material as being appropriate to evidence as opposed to argument at a hearing (or written submissions in lieu of a hearing) nor is it necessarily needed for the purposes of coming to a decision on the central issue. What follows is, therefore, a brief review of the ground covered by the evidence rather than a full summary of its contents. I have nevertheless read all the evidence thoroughly and take it into account as appropriate in my decision.

Opponents' evidence (Rule 13(3))

The opponents filed two statutory declarations in support of their case. The first dated 17 January 1997 comes from Thomas Edward Stopforth, the Managing Director of Kangaroos Limited. He says that his company has been involved in the import and distribution in the United Kingdom of the opponents' goods since January 1995. Prior to that importation and distribution was undertaken by a company called Kangaroos (UK) Limited. Mr Stopforth does not say what relationship existed between the two companies.

He goes on to give an indication of the scale of the opponents' business in this country and the reputation arising therefrom. As I am not dealing here with a claim that registration of the mark at issue is liable to be prevented by the law of passing off I do not propose to review the use position in detail. Suffice to say that the mark KangaROOS has been used for a number of years particularly in relation to footwear with turnover in 1995 of approximately £358,000. In the same year £222,500 was spent on advertising and promotion. Examples of press

cuttings, advertisements and editorial mention of goods bearing the marks are exhibited. A further set of turnover figures is given in relation to goods bearing the kangaroo device showing wholesale figures of £1.3 million in 1987 rising to £4.3 million in 1995.

5 In relation to the marks Mr Stopforth says that the mark applied for would be seen as a
variant of the marks belonging to the opponents; that it is known for companies to use variant
forms of their marks (he refers to various examples of the Lloyds Bank BLACK HORSE
mark); that the applicants cannot claim that the word CLASSIC appearing in their mark is
10 other than a non-distinctive element and that the word CLASSIC is in common use in the
clothing trade.

The second declaration also dated 17 January 1997 is from Michael Gregory Foster, the trade
mark agent at Mewburn Ellis responsible for the conduct of the case on behalf of the
opponents. In summary he makes the following points:-

- 15
- in response to the applicants' counterstatement he confirms registration
No 1228133 is now in the name of Asco Group Limited following a name
change

 - 20 - he says that the only elements of the mark applied for which differ from the
opponents' registration No 1581658 is the elliptical surround and the word
CLASSIC

 - he refers to the Registry's Work Manual in support of his view that elliptical
25 borders are considered to be devoid of distinctive character

 - he exhibits the results of a database search showing 46 registrations in Class
25 containing the word CLASSIC or CLASSICS. He also refers to a reference
in the Registry Work Manual suggesting that the word may be unregistrable
30 and referring to W N Sharpe Ltd v Solomon Bros Ltd 1915 RPC 15

 - he makes a number of observations on "mirror image" devices.

Applicants' evidence (Rule 13(5))

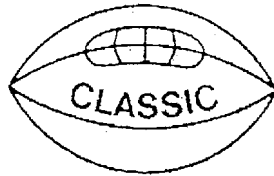
35 The applicants filed seven statutory declarations. The first dated 30 June 1997 comes from
Brian Smelt, the proprietor of International Rugby Tours of Hull who has distributed the
applicants' products for a number of years. The particular products he has sold in the
United Kingdom have been sports clothing, particularly football jerseys, football shirts and
40 shorts. He describes his business as follows:-

45 "I have been connected with rugby (especially rugby league) for many years. Since
1984 I have been responsible for arranging the travel, visa and other arrangements for
Australian players coming to play in England. I have also taken tours to Australia,
and also New Zealand, for supporters and amateur league players. When members of
these tours have arrived in Australia they have invariably asked me how to obtain

Classic jerseys, which shows that they have been familiar with the applicant's name and mark before leaving England.”

Mr Smelt says that the applicants have an existing trade mark registration in the United Kingdom in Class 25 under No 1425328 as follows:-

10



He exhibits an example of an advertisement showing use of the above mark. Sales of what he describes as CLASSIC products have mainly been through mail order and reached a figure of £120,000 per annum. Mr Smelt believes that the mark applied for would be readily associated with the applicants' registered mark because of the word CLASSIC and the shape of the rugby ball. The kangaroo device, in his view, simply serves to emphasise the Australian origin of the applicants' goods.

The second declaration, dated 22 July 1997, comes from Philip John Peacock, a partner in the firm of Solicitors, Radcliffes Crossman Black, who is responsible for the application on behalf of Classic Manufacturing (Aust) Pty Limited. He comments extensively on the marks and the opponents views. In summary he says that:-

- 25 - the applicants' mark must be considered as a totality comprising three elements - the kangaroo, the oval shape and the word CLASSIC
- the oval shape and the word CLASSIC must not be ignored in either registrability or comparison of marks terms
- 30 - the applicants use the word CLASSIC in a trade mark sense and it "is not merely laudatory". He later adds that it is used as the established name of the manufacturer of the products
- 35 - he exhibits other examples of registrations of kangaroo devices
- he seeks to distinguish his clients' kangaroo device from that of the opponents by a detailed comparison of the marks
- 40 - the opponents have produced no evidence of copying
- the opponents' marks also carry the word KangaROOS as an additional distinguishing feature.

45 He concludes that the applicants' mark is distinctive and not confusingly similar to the opponents' marks.

The remaining declarations are all dated June 1997 and come from Karen Brinkman, Esther Brooking, Elizabeth Jeffreys-Jones, Cheryl Kasler and Mary Murphy, all of whom are employed by Radcliffes Crossman Black, the solicitors acting for the applicants. They variously say that the word CLASSIC is a dominant element of the applicants' mark; that they do not consider the respective marks to be in any way confusing and that any familiarity with the opponents' mark is in respect of footwear rather than clothing at large.

Opponents' evidence in reply (Rule 13(6))

The opponents' reply evidence comes in the form of a further statutory declaration by Michael Gregory Foster dated 23 October 1997. Mr Foster's declaration runs to six pages of detailed rebuttal of the applicants' evidence. In summary:-

- he criticises aspects of the supporting declarations by employees of Radcliffes Crossman Black
- he says that it is not clear from Mr Smelt's evidence that members of the tour are using CLASSIC in a trade mark sense when placing orders
- he says that the applicants' new CLASSIC mark is substantially different from the existing registration
- he comments further on the basis on which the comparison of marks issue should be considered
- he comments on other registrations containing kangaroo devices
- he says that the applicants' French application has been refused in opposition proceedings (Opposition 95-605)
- he offers further observations on the respective marks and the word CLASSIC (by reference to the COUNTRY CLASSIC Trade Mark case 1993 RPC 524).

That concludes my review of the evidence. I will deal firstly with opposition based on Section 5(2)(b) of the Act. This Section reads as follows:-

“5.-(2) A trade mark shall not be registered if because -

- (a)
 - (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,
- there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

The term earlier trade mark is defined in Section 6 as follows:-

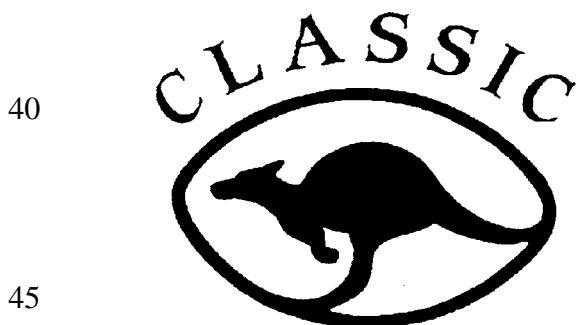
“6.-(1) In this Act an “earlier trade mark” means -

- 5 (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,
- 10 (b) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), or
- 15 (c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention as a well known trade mark.

20 (2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

The opponents refer in their statement of grounds to a number of applications and registrations. The position at the time of writing this decision is that two applications
25 (Nos 1520185 and 1520188) have not yet reached registration themselves. Their position must, therefore, be considered in the context of Section 6(2) above which makes it clear that the protection afforded to an application is made conditional upon it achieving registration. Applications No 1520185 and 1520188 fail this test. The opponents do, however, have two registrations viz numbers 1228133 (which I accept is now in the name of the opponents) and
30 1581658. It will be convenient to take the latter for comparison purposes because if the opponents do not succeed on the basis of their mark incorporating a device I do not think they would be in a better position so far as the word mark on its own is concerned. Equally, as the results of a finding in the opponents’ favour would be mandatory there would be no need to consider their other registration. For ease of reference I set out below the marks at issue:-

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In comparing the marks I take as my starting point the well known test propounded by Parker J in Pianotist Co's application 1906 23 RPC 774 at page 777 line 26 et seq:

5 "You must take the two words. You must judge of them both by their look and by
their sound. You must consider the goods to which they are to be applied. You must
consider the nature and kind of customer who would be likely to buy those goods. In
10 fact, you must consider all the surrounding circumstances; and you must further
consider what is likely to happen if each of these trade marks is used in a normal way
as a trade mark for the goods of the respective owners of the marks. If, considering all
those circumstances, you come to the conclusion that there will be a confusion - that
15 is to say - not necessarily that one will be injured and the other will gain illicit benefit,
but that there will be a confusion in the mind of the public, which will lead to
confusion in the goods - then you may refuse the registration, or rather you must
refuse the registration in that case."

15 Additionally in this case it seems to me that there are a number of other guiding principles to
which I should have regard in reaching my decision. Firstly, whilst it is perhaps inevitable
that in expressing a view on the marks reference will be made to component elements, in the
final analysis it is the totality of the marks at issue which I must consider (see ERECTIKO
20 case 1952 RPC 136). I also bear in mind the guidance in De Cordova v Vick, 1951 RPC 103
at page 106 lines 17-23:

25 "The likelihood of confusion or deception in such cases is not disproved by placing
the two marks side by side and demonstrating how small is the chance of error in any
customer who places his order for goods with both the marks clearly before him, for
orders are not placed, or are often not placed, under such conditions. It is more useful
to observe that in most persons the eye is not an accurate recorder of visual detail and
30 that marks are remembered by general impressions or by some significant detail than
by any photographic recollection of the whole."

30 and the following passage from Savile Perfumery 1941 RPC 147 at page 162 lines 1-9 in
relation to the essential features of marks:-

35 "In the present case, for example, the evidence makes it clear that traders who have to
deal with a very large number of marks used in the trade in which they are interested,
do not, in practice, and indeed cannot be expected to, carry in their heads the details of
any particular mark, while the class of customer among the public which buys the
goods does not interest itself in such details. In such cases the mark comes to be
40 remembered by some feature in it which strikes the eye and fixes itself in the
recollection. Such a feature is referred to sometimes as the distinguishing feature,
sometimes as the essential feature, of the mark."

45 Much has been made in the evidence of points of differentiation between the marks and the
significance or otherwise of elements within each of the marks, particularly the word
CLASSIC. There have also been submissions about the state of the register and the use of
variant forms of marks, stylistic variations and mirror images. Whilst it is understandable

that the parties wish to vigorously contest the matter, over-analysis of some of these issues is not necessarily a very productive process and seems to me to be far removed from the issue of whether there is likely to be confusion on the part of the public. It is this latter point that I must consider taking into account normal circumstances of trade (see the PIANOTIST test
5 above). I do not, therefore, propose to respond in detail to each and every argument that has been advanced though I will comment briefly on the word CLASSIC appearing in the applicants' mark as it has generated much debate and is relevant to my overall approach to, and consideration of, the issue of comparison of marks.

10 I have acknowledged above that I must consider the marks as wholes but that is not the same as saying that every element in a composite mark has equal weight. It seems to me that the more descriptive or non-distinctive a particular word or device is, the less likely that element is to contribute to the overall character of the mark. I do not for current purposes need to take a view on whether the word CLASSIC is registrable or not. Suffice to say that in the light of
15 reported cases, established Registry practice and the position in trade (particularly the clothing industry) it is clear that anyone seeking to register the word will face the gravest possible difficulties. I am aware that in this particular case the applicants say that the word CLASSIC is used "as the established name of the manufacturer of the product". However I can give little credence to this proposition. The company name is Classic Manufacturing
20 (Aust) Pty Limited and not CLASSIC solus. It follows from all this that I take the view that the word CLASSIC makes little if any contribution to the overall character of the applicants' mark. It also has the consequential effect of focusing attention on the device element of the applicants' mark, namely the silhouetted kangaroo contained within an elliptical shape. I regard the silhouetted kangaroo as being an essential and dominant feature of both parties'
25 marks. It is the feature which will in my view fix itself on the consciousness of the purchasing public and be the element by which the mark is remembered. It is true that the opponents' mark also contains the word KangaROOS with the third syllable picked out in capital letters but I do not think that this detracts from the general conclusion I have reached as the word describes the device contained in the mark.

30 I do not forget that Mr Smelt says that members of rugby tours he has been connected with have asked him "how to obtain Classic jerseys". There is, however, no indication of the circumstances in which such enquiries were made, what mark they were referring to or whether it was simply an abbreviated reference to the manufacturer. Nor, of course, is there
35 any independent evidence in corroboration of this claim. There is also the evidence from Radcliffes Crossman Black's own employees but again I do not find such evidence to be particularly persuasive. It is not clear in what context they were asked to comment on the respective marks and, on the face of it, it seems unlikely that their responses in a relatively controlled environment can necessarily be regarded as indicative of how the purchasing
40 public might react under normal retail trading circumstances.

I have also considered the state of the register arguments advanced by the applicants but I do not think they help their cause. Most of the marks referred to are either highly stylised and quite different representations of kangaroos, contain other trade mark matter or have
45 proceeded on the basis of honest concurrent use or consent. I also have no information as to whether the state of the register reflects the position in the marketplace.

I have in the event come to the clear view that the essential feature by which the respective marks are likely to be known is the silhouetted device of a kangaroo. This feature is, of course, absent from the applicants' existing registration No 1425328, referred to above. It follows that the applicants' claim that the mark at issue here is a development of their
5 existing mark is of no assistance to them. In the event I consider the marks to be similar and that there is a likelihood of confusion on the part of the public. The opposition, therefore, succeeds under Section 5(2)(b).

This finding effectively decides the matter but for the sake of completeness I will deal briefly
10 with the other grounds raised by the opponents. They say that the applicants' kangaroo device so nearly resembles their own that use of the former would offend against the provisions of the Copyright, Designs and Patents Act 1988 and therefore the application ought to be refused under Section 5(4)(b). The latter reads as follows:-

15 “(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

(a)

20 (b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

25 A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

The opponents have not developed this claim in their evidence though it appears to have been taken by the applicants as a suggestion that their mark has been copied from the opponents. I can find no indication that the opponents claim copyright in their kangaroo device though I
30 see from their evidence (notably Exhibit TES1 to Mr Stopforth's declaration) that they draw attention to trade mark registration rights in their marks, where these exist. There is nothing before me to indicate that the device of a kangaroo has been copied. It is not an identical device and I see no reason to doubt that the applicants came to their mark other than by honest means. The opposition based on Section 5(4)(b) fails accordingly.

35 The final ground is under Section 3(1)(a). This subsection prevents the registration of signs which do not satisfy the requirements of Section 1(1). The latter reads as follows:-

40 “1.-(1) In this Act a “trade mark” means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.”

Again the opponents have not expanded on the basis for this claim. To be successful under this head the opponents would need to demonstrate that the mark at issue is incapable of functioning as a trade mark, that is to say that there is something in the nature of the mark which means that it cannot distinguish the goods or services of one undertaking from those of other undertakings. I see nothing in the inherent characteristics of the applicants' mark considered as a totality which renders it open to objection in this way. Consequently the opposition under Section 3(1)(a) fails.

As the opponents have been successful in these proceedings as a result of my finding under Section 5(2)(b) I order the applicants to pay them the sum of **£635** as a contribution towards their costs.

Dated this 2nd day of February 1998

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M REYNOLDS
For the Registrar
the Comptroller-General

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